

REMARKS

The September 2, 2005 final Office Action regarding the above-identified application has been carefully considered; and the amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action. The independent claims have been amended to add features that Applicants believe clearly distinguish over the applied art. Two dependent claims are cancelled in view of the language now recited in the dependent claims. Minor grammatical corrections are made to two dependent claims. At least the cancellations and revisions of dependent claims should reduce issues. For reasons discussed below, it is believed that this case is in condition for allowance.

The independent claims have been amended to add recitations relating to a feature by which printing is allowed for digital information (1) when the copy control information would permit making a copy of digital information, e.g. when the copy control information indicates 'copy free' or 'copy one generation,' and (2) when the digital information has been obtained by permissible copying but the copy control information would permit no further copying of the digital information, e.g. when the digital information obtained by permissible copying is thereafter designated for 'no more copies' permitted. The new claim language also adds recitations to the effect that printing of the digital information is disabled when the copy control information completely inhibits the copying of the digital information, e.g. when the copy control information indicates 'copy never.' These features relating to printing control based on the states of the copy control information find support in the original disclosure of the application, e.g. in Table 3 on page 20 of the specification and original claim 13. Hence, these amendments to the independent claims should not raise any new matter concerns.

Claim 13 included even more specific recitations on a related point. At the time of the final rejection, that claim specified that the printing is performed when said copy control

information is either "Copy Free," "Copy One Generation" or "No More Copy," which allow a move operation; but the printing is not performed when "Copy Never" prevents the move. Although the new recitations in the independent claims are not identical to the noted dependent claim, in view of the requirements recited in previously rejected claim 13, it is believed that the new recitations in the independent claims should not require further search or consideration by the Examiner.

Since the claim amendments do not raise new matter concerns and should not raise any issue requiring further search or consideration by the Examiner, it is believed that entry of the claims amendments is proper under Rule 116. Prompt entry of the claim amendments and favorable reconsideration of this amended application are requested.

The issues raised in the latest Action all relate to patentability over the art. A summary of the art rejections and a detailed discussion of patentability of the claims follow.

Claims 1-20 were considered in the September 2, 2005 final Office Action. The Action set forth a rejection of claims 1-6 and 8-20 under 35 U.S.C. §103 as unpatentable over previously applied European application publication no. 1,085,740 to Teruhiko et al. (hereinafter Teruhiko), in view of US application publication no. 2002/0141737 to Fuchigami. Claim 7 stands rejected under 35 U.S.C. §103 over as unpatentable the Teruhiko publication and Fuchigami, further in combination with US application publication no. 2002/0056115 to Yoneda et al. (hereinafter Yoneda). The independent claims have been amended to more clearly distinguish over the art as applied in these rejections. It is believed that the claims are now patentable over the applied art and that the rejections should be withdrawn in view of Applicants' amendments and the following explanation of patentability.

Each of the independent claims now requires that printing of the digital information is controlled based upon copy control information in such a manner that:

(1) the printing of said digital information is allowed when said copy control information would permit making a copy of said digital information;

(2) the printing of said digital information is allowed when said digital information has been obtained by permissible copying but copy control information would permit no further copying of said digital information; and

(3) the printing of said digital information is disabled when said copy control information completely inhibits the copying of said digital information.

In the example discussed in the specification, with regard to table 3, the printing of digital information is allowed when the copy control information is 'copy free' or 'copy one generation' or when the digital information has been obtained by permissible copying but copy control is now set to 'no more copies.' In that example, printing of digital information is disabled when the copy control information is 'copy never.'

It is respectfully submitted that neither the combination of Teruhiko and Fuchigami nor the combination of Teruhiko, Fuchigami and Yoneda would satisfy these new recitations of the independent claims. In particular, the claims now require that printing is still permitted when the digital information has been obtained by permissible copying but copy control information would permit no further copying of the digital information. In the example of Applicants' table 3, this would be when the copy control is set to 'no more copies.' It is believed that the proposed combinations would not suggest print control in a manner that permits printing when the digital information has been obtained by permissible copying but copy control information would permit no further copying of the digital information, e.g. in the 'no more copies' situation.

As discussed at length in the previous response, Teruhiko teaches adding a print control descriptor, to video image data or still image data. The added print control descriptor contains a printing permission flag and information as to the number of times of printing that are permitted. A static image print control device detects the print permission flag for an image, from the print control descriptor. The printer is permitted to print out the static image only when the flag indicates permission is granted. When non-permission is written into the print control descriptor, printout by the printer is inhibited. Attention is directed, for example, to the abstract. In at least one embodiment, that includes a copy control descriptor, the print control descriptor is an additional element (see e.g. paragraphs [0084] and [0085]). It is respectfully submitted that, with Teruhiko's approach, the printing is not controlled based on the state of the copy control information associated with the received digital information but based upon the state of the printing permission flag and information as to the number of times of printing that are permitted contained in the additional print control descriptor.

In the background description of related art (paragraphs [0003] to [0007]), Teruhiko does discuss a pre-existing copy control in video reproduction based on a copy control descriptor, such as that provided by the Copy Generation Management System (CGMS). Teruhiko notes, however, that the copy control descriptor used in CGMS would not be an effective technique for controlling static image printout (paragraph [0007]). This background discussion in Teruhiko would not suggest the specific control based on states of the copy control information in the manner recited in the claims, particularly that printing is still permitted when the digital information has been obtained by permissible copying but copy control information would permit no further copying of the digital information.

The rejection that includes the independent claims combines Fuchigami with Teruhiko, and it cites Fuchigami for an alleged teaching to use copy control information to control recording/reproducing as well as printing. With regard to at least some image processing embodiments, such as shown in Figs. 14 and 17, the Fuchigami document discloses that in the presence of a “copy prohibited” signal in a still-picture signal directed to the printer, a still-picture interface circuit prohibits the transmission of the still-picture signal to the printer. In the absence of a “copy prohibited” signal from a still-picture signal directed to the printer, the still-picture interface circuit permits and executes the transmission of the still-picture signal to the printer (see paragraphs [0117] and [0136]). Modification of Teruhiko in view of such a teaching by Fuchigami would lead to a situation where printing is permitted if there is no “copy prohibited” signal in a still-picture signal and printing is prohibited if there is a “copy prohibited” signal in a still-picture signal. Even this allegedly obvious modification would not lead to an operation wherein printing is still permitted when the digital information has been obtained by permissible copying but copy control information would permit no further copying of the digital information, as now expressly required by the independent claims.

It is noted that claim 13 was included in the rejection over Teruhiko and Fuchigami. With regard to that claim, the rejection alleged that Teruhiko column 5, lines 32-39, disclosed that printing is performed when copy control information is either one of “Copy Free”, “Copy One Generation” and “No More Copy”, allowing the “move”, but on the other hand the printing is not performed when it is “Copy Never” not allowing the “move”. Applicants respectfully disagree. The cited portion of Teruhiko does not correlate printing control to the specifically recited copy control states, in the manner expressed in claim 13. To the contrary, the cited portion of the Teruhiko document actually teaches use of a print permission flag (a 1 or 0 value)

in the print descriptor. Modifying the print flag operation of Teruhiko to disable or enable printing based on the presence or absence of a "copy prohibited" signal in a still-picture signal per Fuchigami would still not meet the requirements of independent claim 8 or of dependent claim 13. There would be no teaching in the combination to still permit printing when the digital information has been obtained by permissible copying but copy control information would permit no further copying of the digital information, as now required by that independent claim. Also, there would be no teaching in either document that indicates that the copy control information is either one of "Copy Free", "Copy One Generation" and "No More Copy", which allow a "move" and is "Copy Never" which disallows the "move," as recited in dependent claim 13. Furthermore, the two documents would not specifically teach that printing is performed when copy control information is either "Copy Free", "Copy One Generation" or "No More Copy" and printing is not performed when the copy control is "Copy Never."

Since the proposed combination of Teruhiko and Fuchigami would not meet all of the recitations of any of the amended independent claims, it is believed that the independent claims patentably distinguish over those two documents. Hence, the obviousness rejection of claims 1-5, 8 and 10-20 over Teruhiko and Fuchigami should be withdrawn in view of the above amendments.

It is respectfully submitted that the further addition of Yoneda does not make up for the deficiencies of the teachings of basic combination of Teruhiko with Fuchigami. The 103 rejection of claim 7 cited Yoneda only for a teaching of descrambling before printout. The Yoneda publication fails to show the distinctive features of the present claims, as discussed above relative to the independent claims. For example, addition of descrambling (Yoneda) would not result in a printer that allows printing when digital information has been obtained by

permissible copying but copy control information would permit us further copying of the digital information. The combination of Teruhiko, Fuchigami and Yoneda therefore does not satisfy all of the recitations of the present independent claims or of rejected dependent claim 7. Hence, the obviousness rejection of claim 7 over those three documents also should be withdrawn.

Upon entry of the above claim amendments, claims 1-5, 7, 8 and 10-20 remain active in this application, all of which should be patentable over the art applied in the Action. Applicants therefore submit that all of the claims are in condition for allowance. Accordingly, this case should now be ready to pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the September 2, 2005 Office Action. However, if any further issue should arise that may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

10/722,076

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Keith E. George". The signature is fluid and cursive, with the first name "Keith" being more prominent.

Keith E. George
Registration No. 34,111

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8603 KEG:apr
Facsimile: 202.756.8087
Date: December 23, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**